

Docket No.: 102164-29  
Serial No.: 10/697,993  
Art Unit: 1744  
Examiner Beisner

### **REMARKS**

The undersigned and William Geary wish to thank Examiner Beisner for the courtesy of a telephone interview on February 18, 2005, during which the outstanding Office Action of November 30, 2004 was discussed. The above amendments are submitted pursuant to the agreements reached during that interview, and which the Examiner indicated would be entered. During the interview, it was agreed that the claim amendments made herein, including new claim 26, obviate the section 112 rejections. In addition, it was agreed that the amended claims distinguish over the cited art. the pending claims are thus deemed to be in condition for allowance. It is believed that all outstanding issues have now been resolved and, hence, reconsideration allowance of this patent application is respectfully requested.

Pursuant to the discussions, claims 1 and 20-25 have been cancelled, and new claim 26 has been added. New claim 26 recites a cell embedding apparatus with a "sample port," a "reagent port," and "a tissue cassette including a removable and replaceable filter." Claims 2-19 have been amended to depend, directly or indirectly, from new claim 26. Support for new claim 26 can be found throughout the specification and Figure 1. No new matter has been added.

#### ***Rejection of Claims 1-19 under 35 U.S.C. 112, Second Paragraph***

Claims 1-19 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to positively claim elements intended to be part of the apparatus.

Claim 1 has been cancelled thereby rendering the rejection moot with regard to this claim. With regard to claims 2-19, these have been amended to depend, directly or indirectly from new claim 26, which claims an apparatus with a "sample port," a "reagent port," and "a tissue cassette including a removable and replaceable filter." As discussed during the interview, new claim 26 positively recites elements intended to be part of the apparatus, and thereby obviates the 35 U.S.C. 112, second paragraph, rejection.

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***Rejection of Claims under 35 U.S.C. 103***

The claims stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shiina *et al.* (JP 2000-146782) in view of Aeikens *et al.* (DE 2928790). The claims also remain rejected under Shiina *et al.*, Aeikens *et al.* and Weiskopf (US 3,227,130) and/or Williamson, *et al.* (US 5,817,032).

As discussed and agreed upon during the interview, new claim 26 distinguishes over Shiina *et al.* and Aeikens *et al.*, either alone, or in combination for the following reasons.

The claimed invention is directed to a cell embedding apparatus that has two separate flow pathways and two separate ports, the sample port, and the reagent port. There is an interrelationship between the two separate ports because the "reagent port [is] in fluid communication with the sample port."

In contrast, Shiina *et al.* only discloses a reagent flow pathway with one port, the "sample/reagent port (2)." There is no teaching or suggestion in Shiina *et al.* for an apparatus with two separate ports. In fact, Shiina *et al.* directly teaches away from such an apparatus by stating that the sample is injected into the same port as the reagents. As the apparatus of Shiina *et al.* only has one port, it would be impossible to have fluid communication between a separate reagent port and a sample port.

Likewise, Aeikens *et al.* only discloses a cell flow pathway with one port, the "sample port (3)." There is no teaching or suggestion in Aeikens *et al.* for an apparatus with two separate ports, and as such, it would be impossible to have fluid communication between the two separate ports.

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In addition, the lack of teaching in these references would provide no motivation for one having ordinary skill in the art to combine the references to arrive at the claimed invention. Thus, Shiina *et al.*, and Aikens *et al.* fail to render the claimed invention obvious.

The deficiencies of Shiina *et al.* and Aikens *et al.* are not remedied by Weiskopf and/or Williamson, *et al.* because none of these references teaches or suggests an apparatus with two separate ports, nor do they provide any teaching to motivate one having ordinary skill in the art to combine the references to arrive at the claimed invention.

#### Conclusion

In view of the foregoing remarks, the claims are deemed to be in a condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call Applicant's Attorney at (617) 439-2994.

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Respectfully submitted,

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